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OFFICE OF PETITIONS

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, LLP
901 NEW YORK AVENUE, NW
WASHINGTON DC 20001-4413

In re Patent No. 7,456,750 :
Popp, et al. : DECISION ON
Application No. 09/837,228 : REQUEST FOR
Issue Date: November 25, 2008 : RECONSIDERATION OF
Filed: April 19, 2001 : PATENT TERM ADJUSTMENT
Attorney Docket No. : AND NOTICE OF INTENT TO
2100.0071-00 : ISSUE CERTIFICATE OF
: CORRECTION

This is in response to the REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT UNDER 37 C.F.R. § 1.705(d), filed January 26, 2009. Patentees request that the determination of patent term adjustment be corrected from one hundred sixty-nine (169) days to six hundred thirty seven (637) days.

The request for reconsideration of the patent term adjustment indicated in the patent is GRANTED to the extent indicated herein.

Patentees are given THIRTY (30) DAYS or ONE (1) MONTH, whichever is longer, from the mail date of this decision to respond. No extensions of time will be granted under 37 CFR 1.136.

The patent term adjustment indicated in the patent is to be corrected by issuance of a certificate of correction showing a revised Patent Term Adjustment of two hundred seventy-two (272) days.

BACKGROUND

This application was filed on April 19, 2001. On April 19, 2005, a request for continued examination was filed. On November 25, 2008, the application matured into U.S. Patent No. 7,456,750 with a revised patent term adjustment of 169 days. The Office determined that the 365 days of Office delay pursuant to 35

U.S.C. 154(b)(1)(B) and 37 CFR 1.702(b)^{1,2} overlaps with the 669 days of Office delay pursuant to 35 U.S.C. 154(b)(1)(A) and 37 CFR 1.702(a)(1)³ accorded prior to the issuance of the patent. A period of adjustment of 634 days of Office delay subsequent to the filing of the request for continued examination was entered pursuant to 37 CFR 1.702(e). No additional days of patent term adjustment were entered at issuance under the three-year pendency provision. The patent issued with a revised patent term adjustment of 169 days (669 days of Office delay - 500 days of applicant delay).

On January 26, 2009, patentees timely submitted this request for reconsideration of patent term adjustment (with required fee). In part, patentees dispute the reduction of 103 days associated with the filing of the "Declaration and Power of Attorney" on

¹ Pursuant to 35 U.S.C. 154(b)(1)(B), 37 CFR 1.702(b) provides, in pertinent part, that:

Failure to issue a patent within three years of the actual filing date of the application. Subject to the provisions of 35 U.S.C. 154(b) and this subpart, the term of an original patent shall be adjusted if the issuance of the patent was delayed due to the failure of the Office to issue a patent within three years after the date on which the application was filed under 35 U.S.C. 111(a) or the national stage commenced under 35 U.S.C. 371(b) or (f) in an international application, but not including:

(i) any time consumed by continued examination of the application requested by the applicant under section 132(b) [.]

² As of the filing of the RCE on April 19, 2005, the application was pending three years and 365 days.

³ 37 CFR § 1.702, provides grounds for adjustment of patent term due to examination delay under the Patent Term Guarantee Act of 1999 (original applications, other than designs, filed on or after May 29, 2000).

(a) Failure to take certain actions within specified time frames. Subject to the provisions of 35 U.S.C. 154(b) and this subpart, the term of an original patent shall be adjusted if the issuance of the patent was delayed due to the failure of the Office to:

(1) Mail at least one of a notification under 35 U.S.C. 132 or a notice of allowance under 35 U.S.C. 151 not later than fourteen months after the date on which the application was filed under 35 U.S.C. 111(a) or fulfilled the requirements of 35 U.S.C. 371 in an international application;

August 15, 2008, after the mailing of the notice of allowance. Specifically, patentees state:

Patentee filed the courtesy copy of the Declaration and Power of Attorney in response to an express request by the Examiner to submit a copy of the originally-filed Declaration and Power of Attorney because the USPTO's copy was apparently no longer present in the USPTO's application file.

The USPTO has apparently improperly viewed the submission of the courtesy copy as a "failure to engage in reasonable efforts to conclude prosecution...of the application," and has reduced the patent term adjustment by 103 days. See 37 C.F.R. 1.704(a)

Patentee respectfully submits that such a reduction is improper because a supplemental paper submitted in response to an Examiner's express request does not constitute a failure to engage in reasonable prosecution efforts. See 37 C.F.R. 1.704(c)(8) (indicating that supplemental replies and other papers expressly requested by the Examiner do not trigger a reduction in a patent term adjustment).

Excerpt from "Request for Reconsideration of Patent Term Adjustment under 37 C.F.R. 1.705(d)", filed January 26, 2009, pgs. 2-3.

Patentees further assert that the correct number of days of Patent Term Adjustment is 637 days under the court's interpretation of the overlap provision as set forth in Wyeth v. Dudas, 580 F. Supp. 2d 138, 88 U.S.P.Q. 2d 1538 (D.D.C. 2008). Specifically, patentees state that:

According to Wyeth, the time period beyond three years of pendency of an application counts toward patent term adjustment for every day that does not occur on the same date as a USPTO delay based on a reason other than the pendency being greater than three years. See Wyeth at 8 ("the only way that periods of time can 'overlap' is if they occur on the same day").

Patentee respectfully submits that the USPTO has failed to provide the '750 patent with 365 days of accrued patent term adjustment based on the period of time between three years after the filing date and the date on which Patentee filed a Request for Continued Examination (RCE).

Excerpt from "Request for Reconsideration of Patent Term Adjustment under 37 C.F.R. 1.705(d)", filed January 26, 2009, p. 3-4.

OPINION

At the outset, patentees' assertion that the 103 days of reduction to the patent term adjustment pursuant to 37 CFR

1.704(c)(8)⁴ for the filing of Declaration and Power of Attorney on August 15, 2008, after the mailing of the notice of allowance, was not warranted is well taken. However, this conclusion is based on reasons different from those stated by patentees. The reasoning is different as the reduction was pursuant to 37 CFR 1.704(c)(10), not 1.704(c)(8) as argued by patentees. On resubmission of the declaration, patentees made a *prima facie* showing in the form of an itemized and date-stamped postcard that a Declaration and Power of Attorney was filed on July 23, 2001. A review of the record supports a conclusion that one page of the originally submitted declaration was lost by the Office. Under the circumstances of the resubmission, it is appropriate to treat the 2-page declaration as submitted on July 23, 2001, prior to the mailing of the Notice of Allowance on July 23, 2008. As such, the resubmission of the lost declaration on August 15, 2008, did not constitute a failure to engage within the meaning of 37 CFR 1.704(c)(10). Accordingly, the 103 day reduction to the patent term adjustment is being removed.

With regard to patentees' interpretation of the period of overlap, the Office has considered it, but finds it inconsistent with the Office's interpretation of the overlap provision, 35 U.S.C. 154(b)(2)(A). 35 U.S.C. 154(b)(2)(A) limits the adjustment of patent term, as follows:

to the extent that the periods of delay attributable to grounds specified in paragraph (1) overlap, the period of any adjustment granted under this subsection shall not exceed the actual number of days the issuance of the

⁴ 37 CFR 1.704 (c)(8) provides that:

(c) Circumstances that constitute a failure of the applicant to engage in reasonable efforts to conclude processing or examination of an application also include the following circumstances, which will result in the following reduction of the period of adjustment set forth in § 1.703 to the extent that the periods are not overlapping:

8) Submission of a supplemental reply or other paper, other than a supplemental reply or other paper expressly requested by the examiner, after a reply has been filed, in which case the period of adjustment set forth in § 1.703 shall be reduced by the number of days, if any, beginning on the day after the date the initial reply was filed and ending on the date that the supplemental reply or other such paper was filed;

patent was delayed.

As explained in *Explanation of 37 CFR 1.703(f)*⁵ and of the United States Patent and Trademark Office Interpretation of 35 U.S.C. 154(b)(2)(A), 69 Fed. Reg. 34283 (June 21, 2004), the Office interprets 35 U.S.C. 154(b)(2)(A) as permitting either patent term adjustment under 35 U.S.C. 154(b)(1)(A)(i)-(iv), or patent term adjustment under 35 U.S.C. 154(b)(1)(B), but not as permitting patent term adjustment under both 35 U.S.C. 154(b)(1)(A)(i)-(iv) and 154(b)(1)(B). Accordingly, the Office implements the overlap provision as follows:

If an application is entitled to an adjustment under 35 U.S.C. 154(b)(1)(B), the entire period during which the application was pending (except for periods excluded under 35 U.S.C. 154(b)(1)(B)(i)-(iii)), and not just the period beginning three years after the actual filing date of the application, is the period of delay under 35 U.S.C. 154(b)(1)(B) in determining whether periods of delay overlap under 35 U.S.C. 154(b)(2)(A). Thus, any days of delay for Office issuance of the patent more than 3 years after the filing date of the application, which overlap with the days of patent term adjustment accorded prior to the issuance of the patent will not result in any additional patent term adjustment. See 35 U.S.C. 154(b)(1)(B), 35 U.S.C. 154(b)(2)(A), and 37 CFR § 1.703(f). See *Changes to Implement Patent Term Adjustment Under Twenty Year Term; Final Rule*, 65 Fed. Reg. 56366 (Sept. 18, 2000). See also *Revision of Patent Term Extension and Patent Term Adjustment Provisions; Final Rule*, 69 Fed. Reg. 21704 (April 22, 2004), 1282 Off. Gaz. Pat. Office 100 (May 18, 2004). See also *Explanation of 37 CFR 1.703(f) and of the United States Patent and Trademark Office Interpretation of 35 U.S.C. 154(b)(2)(A)*, 69 Fed. Reg. 34283 (June 21, 2004).

Further, as stated in the *Explanation of 37 CFR 1.703(f) and of the United States Patent and Trademark Office Interpretation of*

⁵ Likewise, 37 CFR 1.703(f) provides that:

To the extent that periods of delay attributable to the grounds specified in §1.702 overlap, the period of adjustment granted under this section shall not exceed the actual number of days the issuance of the patent was delayed.

35 U.S.C. 154(b)(2)(A), the Office has consistently taken the position that if an application is entitled to an adjustment under the three-year pendency provision of 35 U.S.C. 154(b)(1)(B), the entire period during which the application was pending before the Office (except for periods excluded under 35 U.S.C. 154(b)(1)(B)(i)-(iii)), and not just the period beginning three years after the actual filing date of the application, is the relevant period under 35 U.S.C. 154(b)(1)(B) in determining whether periods of delay "overlap" under 35 U.S.C. 154(b)(2)(A).

This interpretation is consistent with the statute. Taken together the statute and rule provide that to the extent that periods of delay attributable to grounds specified in 35 U.S.C. 154(b)(1) and in corresponding §1.702 overlap, the period of adjustment granted shall not exceed the actual number of days the issuance of the patent was delayed.

In this instance, the relevant period under 35 U.S.C. 154(b)(1)(B) in determining whether periods of delay "overlap" under 35 U.S.C. 154(b)(2)(A) is the period during which the application was pending before the Office beginning on the application filing date under 35 U.S.C. 111(a), April 19, 2001, and ending on the date of filing of a request for continued examination (RCE), April 19, 2005, (not including any other periods excluded under 35 U.S.C. 154(b)(1)(B)(i)-(iii)). The relevant period ends with the filing of the RCE as the three-year time frame specified in 35 U.S.C. 154(b)(1)(B) does not include the period subsequent to the filing of the RCE. 35 U.S.C. 154(b)(1)(B)(i).

Thus, only the 26 days of patent term adjustment accorded prior to the filing of the request for continued examination pursuant to 37 CFR 1.702(a)(1) is considered in determining overlap. The 634 days for Office delay under 37 CFR 1.702(e) occurring subsequent to the filing of the request for continued examination is not considered.

All of the 365 days of patent term adjustment under 37 CFR 1.702(b) overlap with the 26 days of patent term adjustment under 37 CFR 1.702(a)(1). 669 days (26 + 634) is the actual number of days issuance of the patent was delayed.

CONCLUSION

In view thereof, the patent term adjustment indicated on the patent should be two hundred seventy-two (272) days (669 (26 + 643) days of Office delay - 397 (31 + 90 + 90 + 59 + 91 + 36) days of applicant delay).

This matter is being referred to the Certificates of Correction Branch for issuance of a certificate of correction in order to rectify this error. The Office will issue a certificate of correction indicating that the term of the above-identified patent is extended or adjusted by **272 days**.

The Office acknowledges submission of the \$200.00 fee set forth in 37 CFR 1.18(e). No additional fees are required.

Telephone inquiries specific to this matter should be directed to Kenya A. McLaughlin, Petitions Attorney, at (571) 272-3222.

Christina Tartera Donnell

Christina Tartera Donnell
Senior Petitions Attorney
Office of Petitions

Enclosure: Copy of DRAFT Certificate of Correction

DRAFT COPY

UNITED STATES PATENT AND TRADEMARK OFFICE

CERTIFICATE OF CORRECTION

PATENT : 7,456,750 B2

DATED : Nov. 25,2008

INVENTOR(S) : Popp, et al.

It is certified that error appears in the above-identified patent and that said Letters Patent is hereby corrected as shown below:

On the cover page,

[*] Notice: Subject to any disclaimer, the term of this patent is extended or adjusted under 35 USC 154(b) by (169) days

Delete the phrase "by 169 days" and insert – by 272 days--